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**REMARKS**

In the Office Action, the Examiner rejected Claims 1-15, which were all of the then pending claims, over the prior art, principally U.S. Patent 6,300,947 (Kanevsky). More specifically, Claims 1, 4, 6, 9, 11 and 14 were rejected under 35 U.S.C. §102 as being fully anticipated by Kanevsky; Claims 2, 3, 7, 8, 12 and 13 were rejected under 35 U.S.C. §103 as being unpatentable over Kanevsky in view of a document "Web Workshop Java Script" (Lemay); and Claims 5, 10 and 15 were rejected under 35 U.S.C. §103 as being unpatentable over Kanevsky in view of U.S. Patent 6,163,780 (Ross). The Examiner also objected to certain words in the Abstract.

Independent Claims 1, 6 and 11 are herein being amended to better define the subject matters of these claims. New Claims 16 and 17, which are dependent from Claim 1, are being added to describe preferred features of the invention.

Also, the Abstract is being amended to address the Examiner's objection. In particular, the Examiner objected to the terms "comprises" and "comprise" and these words are being changed to "includes" and "include" respectively. It is believed that the latter terms are considered by the Patent Office more appropriate for an Abstract, and it is thus believed that these changes overcome the Examiner's objection. The Examiner is, hence, respectfully asked to reconsider and to withdraw the objection to the Abstract.

For the reasons set forth below, Claims 1-17 patentably distinguish over the prior art and are allowable. The Examiner is, accordingly, also requested to reconsider and to withdraw the above-identified rejections of Claims 1-15, and to allow these claims and new Claims 16 and 17.

The present invention, generally, relates to methods and systems for downloading files over computer networks, and this is done by removing certain matter from the files. An important feature of the invention is that the file size is reduced without changing the page layout format of the file.

This feature of the invention is not disclosed in or suggested by Kanevsky. In fact, Kanevsky takes a completely different approach.

To elaborate, Kanevsky discloses a procedure for adapting Web pages to different types of display devices, such as a personal computer, a multiscreen PC, a laptop computer, and a webphone. To do this, the page formatting is changed to meet the requirements of the different display devices.

The present invention does not do this, and actually has a different objective. The objective of this invention is to increase the speed at which the file is downloaded without going through the formatting changes used in Kanevsky.

Claims 1, 6 and 11 clearly describe this feature of the invention. Specifically, Claims 1 and 11 both describe the step of reducing the size of a requested web file, while maintaining the page layout format of the requested file, by removing pre-identified subject matter from the file. Claim 6, which is directed to a system for preparing a web content file for downloading over a computer network, describes analogous apparatus limitations.

The other references of record have been reviewed, and these other references, whether they are considered individually or in combination, also do not disclose or suggest the above-discussed feature of the invention, in the contexts of Claims 1, 6 and 11.

For example, Ross discloses procedures for condensing computer code. Ross, however, works with byte code, while the present invention, in contrast, works with source code. Byte code is the highest level of abstraction – the actual 0s and 1s that are read by the computer. Source code is the human readable code. Also, the source code, when modified by the present invention, does not require re-compiling, while the modified byte code of Ross does need to be recompiles. Thus, Ross and the present invention address very different situations and provide solutions for different specific problems.

The Lemay document teaches the use of various Javascript functions and comments. In the Office Action, the Examiner argued that it would have been obvious to combine Kanevsky and Lemay. The teaching of Kanevsky, however, is to prepare documents for display on different types of display devices having different formats. Thus, even if Kanevsky and Lemay are combined, the result would still be substantially different from the present invention – where the page format is maintained.

Because of the above-discussed differences between Claims 1, 6 and 11 and the prior art, and because of the advantages associated with those differences, Claims 1, 6 and 11 patentably distinguish over the prior art and are allowable. Claims 2-5, 16 and 17 are dependent from, and are allowable with, Claim 1. Similarly, Claims 7-10 are dependent from Claim 6 and are allowable therewith; and Claims 12-15 are dependent from, and are allowable with, Claim 11. The Examiner is, consequently, respectfully requested to reconsider and to withdraw the rejection of Claims 1, 4, 6, 9, 11 and 14 under 35 U.S.C. §102, and the rejections of Claims 2, 3, 5, 7, 8, 10, 12 and 13 under 35 U.S.C. §103, and to allow Claims 1-17.

Separate from, and in addition to the foregoing, Applicants ask that the rejections of Claims 2, 3, 5, 7, 8, 10, 12, 13 and 15 under 35 U.S.C. §103 be withdrawn because Kanevsky is not a proper reference that can be applied under 35 U.S.C. §13. This, in turn, is because the present application and Kanevsky are assigned to the same corporation, IBM Corporation. Applicants submit that the filing of the present application March 20, 2001, brings the subject application under the rubric of the amendments made to the Patent Laws in the American Inventors Protection Act of 1999. That Act, enacted November 29, 1999, amends 35 U.S.C. '103(c) such that subject matter developed by another person which qualifies as prior art under 35 U.S.C. '102(e) does not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an application of assignment to the same person.

That this section applies to the instant application is established by the Guidelines concerning the implementation of changes to 35 U.S.C. '102(g) and 103(c) published in the Official Gazette on April 11, 2000. Those Guidelines includes the statement that the amendment to 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 C.F.R. '1.53(d), continued prosecution applications filed under 37 C.F.R. '1.53(b) and reissues. In view of the filing of the present application on March 20, 2001, under 37 C.F.R. '1.53(b), applicants benefit from the statutory restraints imposed in the amendment to '103(c).


That the claims of the present application are patentable over the rejection of record is established by the fact that Kanevsky is, on its face, assigned to International Business Machines. The instant application is also assigned to International Business Machines. The Assignment of the instant application to International Business Machines by the applicants of the present application was mailed March 20, 2001 to the USPTO for recording. The Assignment was recorded by the USPTO on March 20, 2001, at Reel 011645, Frame 0952.

U.S. Patent 6,300,947 to Kanevsky issued October 9, 2001. The present application is entitled to the benefit of the filing date of March 20, 2001. As such, the outstanding rejection of claims 2, 3, 5, 7, 8, 10, 12, 13 and 15 of the present application applies the Kanevsky patent predicated upon its availability as a reference under 35 U.S.C. '102(e) in that this is the only subsection of 35 U.S.C. '102 whose requirements are met by this patent.

In view of the requirements of 35 U.S.C. '103(c), as amended November 29, 1999, which apply to the instant application, the principal Kanevsky reference cannot preclude patentability under 35 U.S.C. '103, the section upon which the claims 2, 3, 5, 7, 8, 10, 12, 13 and 15 of the present application have been rejected. Thus, these claims of the present application are patentable over the outstanding rejection of record. Reconsideration and removal of this ground of rejection is therefore deemed appropriate. Such action is respectfully urged.

In light of the above comments, the Examiner is asked to reconsider and to withdraw the objection to the Abstract. The Examiner is also respectfully requested to reconsider and to withdraw the rejection of Claims 1, 4, 6, 9, 11 and 14 under 35 U.S.C. §102, and the rejections of Claims 2, 3, 5, 7, 8, 10, 12 and 13 under 35 U.S.C. §103, and to allow Claims 1-17. If the Examiner believes that a telephone conference with Applicants= Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

  
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